

## **DISCUSSION**

Upon entry of the present Amendment, claims 2-10 are pending in the application, of which, claims 2, 4 and 6 are each independent. The application has been held under suspended Examination under 37 CFR 1.103(c) as requested by applicant on December 26, 2008.

The Office Action of 29 August 2008 has been further reviewed, the references carefully considered, and the Examiner's comments carefully weighed. In view thereof, the present Amendment is submitted.

It is respectfully submitted that by the present amendment, all bases of rejection set forth in the Office Action have been traversed and overcome. Accordingly, reconsideration and withdrawal of each of the rejections of record is respectfully requested.

## **AMENDMENTS PRESENTED**

***In the specification:*** The specification has been amended to provide support for the drawing addition to figure 1. Figure 1 has been amended to show a portion of the vehicle 100 as required by the previous Office Action.

***In the claims:*** Claims 2, 4 and 6 have each been rewritten into independent form herein, to include all of the limitations of claim 1, which has now been canceled. Claims 3 and 5 have been amended to depend from claim 2, and new claims 7-10 are similar to claims 3 and 5 depending from claims 4 and 6, respectively.

Applicant respectfully submits that the above amendments to the claims and specification, including new claims, are fully supported by the original disclosure including the drawings. Applicant also respectfully submits that no new matter is introduced into the application by amending the claims and specification, and by adding new claims, since all of the subject matter thereof was expressly or inherently disclosed in the specification, claims and drawings, as originally filed.

## **DRAWING OBJECTIONS**

Previously, the Examiner objected to the drawings under 37 CFR 1.83(a) as failing to show a vehicle (claimed in claim 4).

***Applicant's Response:*** Applicant submits herewith an amended figure 1 which shows a portion of the vehicle 100. No new matter is added by this drawing amendment, because numerous references are made throughout the original specification to a vehicle, including paragraphs [0029] and [0037] among other instances.

Accordingly, applicant respectfully requests reconsideration and withdrawal of the objection to the drawings, in light of the present amendment.

## **CLAIM REJECTIONS -- 35 USC 112**

1. Previously, the Examiner has rejected claim 6 under 35 USC 112, first and second paragraph. Specifically, the Examiner has taken the position that claim 6 is rejected under 35 USC 112, first paragraph, for failing to comply with the enablement requirement because in the Examiner's view, the claimed subject matter was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention; the claim states that the pin hole would not have an inlet or outlet for gases and the pin hole is smooth.

### ***Applicant's Response:***

Contrary to the Examiner's assertion, the first paragraph of Section 112 is directed to the specification, rather than to the claims, and requires an enabling disclosure.

The first paragraph of 35 U.S.C. §112 reads as follows:

**The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.**

Applicant respectfully submits that the specification of the present application contains an enabling disclosure, and is in full compliance with the requirements set forth in the first paragraph of 35 U.S.C. 112.

In considering whether there is 35 U.S.C. 112, ¶ 1 support for a claim limitation, the examiner must consider not only the original disclosure contained in the summary and detailed description of the invention portions of the specification, but also the original claims, abstract, and drawings. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991) (drawings); *In re Wolfensperger*, 302 F.2d 950, 955-957, 133 USPQ 537, 541-543 (CCPA 1962) (drawings).

The second paragraph of 35 U.S.C. §112 reads as follows:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Additional guidance on this point can be found in the Manual of Patent Examining Procedure. MPEP 2173.02 states as follows, on the subject of the standard under the second paragraph of section 112:

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in

the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

In the case of *Solomon v. Kimberly-Clark Corp.*, *supra*, the court stated:

The definiteness of the language employed must be analyzed - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art....Determining whether a claim is definite requires an analysis of whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.

(upholding validity of a claim which included the terms "relatively thick layer" and "substantially thinner layer").

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are able to act as their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose, so long as any special meaning assigned to a term is clearly set forth in the specification. See MPEP §§ 2111.01, 2173.01. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. (MPEP 2173.02) See *Morton Int'l, Inc. v. Cardinal Chem.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190 (CAFC 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph,

but the Examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the Examiner should suggest improved language to the applicant.

In the case of *In re Venezia*, 189 USPQ 149, 151-152 (CCPA 1976), the Court of Claims and Patent Appeals explicitly addressed the question of whether claim elements including the language "adapted to" were in compliance with the requirements of 35 USC 112. The invention at issue in *Venezia* was a kit of components for building a high-voltage splice connector. The claim at issue in *Venezia* included the terms "capable of being assembled", "adapted to be fitted", "adapted to be affixed", and "adapted to be positioned". The court in *Venezia* stated:

**We have reviewed the disputed claims and in particular the language criticized by the examiner and the board. We conclude that the claims do define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity, and that they are, therefore, definite as required by the second paragraph of section 112 (citations omitted) . . . . More particularly, we find nothing indefinite in these claims. One skilled in the art would have no difficulty determining whether or not a particular collection of components infringed the collection of interrelated components defined by these claims.**

1. Specifically, applicant notes that several paragraphs (20, 21, 22, 23) of the specification and the original drawings show the end opposite the valve as being closed with a pin hole for guiding the tank into the rack of the present invention. See paragraph 3 of the publication for the disclosure of the problem and the proposed solution, a means and method for locating and securing the tank. Figure 8 specifically shows the pin 34 and pin hole 12 relationship with the end of the tank closed at the inner shell 9 by the mounting flange 14. See paragraph 22 and 23 of the publication. In addition, paragraph 20 of the publication states that a gas fuel inlet and outlet valve device 11 is located at a first axial end of the tank 9 and has a pin hole 12 at the other axial end of the tank 9, the pin hole opens outwardly. The original claim 1 states that the pin hole opens outwardly. In addition, paragraph 23

clearly states that the body 10 is provided on the inner shell 9 and does not protrude from the outer shell. Paragraph 22 states that the valve device 11 is provided at a neck portion of the inner shell 9 with the pin hole 12 opened at one end face, and a mounting flange 14 at the other end of the cylindrical body 13. With respect to the smooth inner surface, it is respectfully submitted that the original drawings show the inner surface of the cylinder 13 as being smooth.

However, the pin hole being smooth has been canceled from the claims, thereby overcoming this objection to the specification and claims.

Accordingly, in view of the arguments presented above, applicant respectfully submits that the original specification and drawings fully support the claimed subject matter and thus, applicant respectfully requests the rejection under 35 USC 112, first paragraph be reconsidered and withdrawn.

### **35 USC 103 ISSUES**

1. Previously, the Examiner has rejected claims 1, 4 and 5 under 35 USC 103 as unpatentable over Watanabe et al in view of Takashima. The Examiner has taken the position that Watanabe et al discloses a tank, a support frame for holding the tank horizontally, and an outlet valve and that Takashima is provided to show that it is well known to provide openings at either end of the tank and to provide a tank with wound fibers for strength. Thus, in the Examiner's view, it would be obvious to provide aligned holes on the tank of Watanabe and a wound outer shell in view of the teachings of Takashima.

2. Previously, the Examiner has rejected claims 2, 3 and 6 under 35 USC 103 as unpatentable over Watanabe et al and Takashima, and further in view of Kay. The Examiner has taken the position that it would have been obvious to modify the already modified tank of Watanabe to include a pin and pin hole formed body as taught by the pin hole 69 and pin hole body 65 further in view of Kay.

### ***Applicant's Response:***

Upon careful consideration of the Examiner's rejection and the applied references applicant respectfully traverses such rejections, because the references offer no suggestion or impetus for the proposed hypothetical combination as proffered by the Examiner, and further because the Examiner's rejection appears to be based primarily on the Examiner's use of impermissible hindsight (guided by the applicant's own disclosure) rather than from any teaching that can be fairly gleaned from the references themselves.

Applicant respectfully submits that the prior art fails to teach, disclose or suggest an on-board gaseous fuel tank module as currently claimed.

Applicant respectfully submits that the differences between the claimed invention and the cited references are substantial and significant, and therefore, applicant's invention is non-obvious as compared to the respective teachings of the references.

### **Other Prior Art**

Polletta et al and Idoguchi (JP2004-257413) show prior art tanks that are held in a horizontal position. Polletta is secured in a vehicle. However, neither prior art device shows a multi-layer tank with a pin hole and mounting flange as set forth in claim 7. The "pin" hole of Polletta is a vent and is thus open to the interior of the tank. Idoguchi (JP2004-257413) shows the tank as a single layer and the "pin" hole comprises an inwardly formed depression that does not include a mounting flange as set forth in claim 7. In addition, Idoguchi (JP2004-257413) states that the support means member 6 grips the tank end with an "elastic" member, not a pin.

### **CONCLUSION**

Based on all of the foregoing, applicant respectfully submits that all of the rejections set forth in the Office Action have been overcome, and, as presently amended, all of the pending claims are believed to be allowable over all of the references of record, whether considered individually or in


any reasonable combination thereof. Applicant respectfully requests reconsideration and withdrawal all of the rejections of record, and allowance of the pending claims.

It is applicant's contention that no possible reading of the references, either singly or in any reasonable combination, can be viewed as teaching applicant's claimed invention.

If any issues remain unresolved, or if the Examiner feels that the prosecution of the present application could be advanced by a telephone discussion, the applicant respectfully requests that the Examiner telephonically contact the applicant's undersigned representative, to expeditiously resolve any such issues remaining in the prosecution of the application.

Favorable consideration is respectfully requested.

Respectfully submitted,




/

Customer No. 21828  
Carrier, Blackman & Associates, P.C.  
24101 Novi Road, Suite 100  
Novi, Michigan 48375  
25 March 2009

William Blackman  
Attorney for Applicant  
Registration No. 32,397  
(248) 344-4422

**CERTIFICATE OF ELECTRONIC TRANSMISSION**

I hereby certify that this correspondence is being electronically transmitted, via EFS web, to the United States Patent and Trademark Office on 25 March 2009.



/